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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/088,732

07/22/2002

Karl Heinz Schmid

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23657 7590 08/29/2006

COGNIS CORPORATION  
PATENT DEPARTMENT  
300 BROOKSIDE AVENUE  
AMBLER, PA 19002

EXAMINER

COTTON, ABIGAIL MANDA

ART UNIT PAPER NUMBER

1617

DATE MAILED: 08/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/088,732

Applicant(s)

SCHMID ET AL.

Examiner

Abigail M. Cotton

Art Unit

1617

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 15 August 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see continuation sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

  
**SREENI PADMANABHAN**  
SUPERVISORY PATENT EXAMINER

Continuation sheet (note 11)

The request for reconsideration has been fully considered but does not place the application in condition for allowance. Accordingly, the claims remain rejected for the reasons of record as set forth in the Final Rejection mailed on April 10, 2006.

Applicants have requested that the finality of the rejection be reconsidered and withdrawn because Applicants assert that the Examiner "has presented completely new grounds of rejection in every respect which grounds of rejection were not necessitated by Applicants' minor amendments to the claims." The Examiner notes that it is unclear what Applicants intend by referring to the "minor amendment to the claims," as the prosecution history does not show any amendments made by Applicants in response to the Non-Final Rejection mailed on November 2, 2005. The Examiner has completely reviewed the Final Rejection mailed on April 10, 2006 to determine whether any new grounds of rejection were raised with respect to the Non-Final Office Action mailed on November 2, 2005, and finds that the grounds for rejection as set forth in the two actions are identical, with the exception of minor typo corrections. The Examiner furthermore notes that Applicants have not pointed out what the supposed "new grounds" of rejection are. Accordingly, Applicants' request for the withdrawal of the finality of the rejection mailed on April 10, 2006 is denied.

Applicants argue that the composition as claimed is not obvious over Kahre et al. in view of Weil, or Kahre et al. in view of Wachter et al, because Applicants assert that Kahre et al. requires the hydrocarboxylic acid esters to be an oil, whereas Weil, for example, teaches obtaining a monoester of citric acid as a precipitate, and thus not in a form that is an "oil."

The Examiner respectfully disagrees with this assertion. Kahre et al. is directed to providing fatty compounds that are suitable to replace silicone in cosmetic and/or pharmaceutical preparations. Kahre et al. teaches that the fatty compound substitute can comprise an oil component that is a hydroxycarboxylic acid ester, such as an ester of citric, malic or tartaric acid with an alcohol, such as a long-chain fatty alcohol. Kahre et al. does not specifically teach that the ester is a partial ester, however it is known to those of ordinary skill in the art that an "oil" is by definition a mixture or different compounds, such as different esterified forms, and thus includes partial esterified forms. One of ordinary skill in the art would also recognize that the fabrication of an oil having esters of di-carboxylic acids such as malic or tartaric acid would necessarily yield a mixture of both full and partial esters. Furthermore, Weil et al. and Wachter et al. teach that the specific partial ester forms as recited in the claims are suitable for topical use. Accordingly, it is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to provide the hydroxycarboxylic acid esters of Kahre et al, and including partial esters of the hydroxycarboxylic acids, with the

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expectation of providing a suitable composition having the fatty substances for topical application.

Applicants also argue that Weil et al. teaches that di and tri-esters of citric acid severely limit foaming, and thus that it would not be obvious to combine the esters of Weil et al. in the composition of Kahre et al. The Examiner notes that Weil et al. does not teach that the monoester would be problematic with foaming, and thus it is considered that it would be obvious to combine the monoester of Weil et al. into the composition of Kahre et al.

Applicants also argue that Kahre et al. and the other references do not teach the improved foam stability or mucous membrane compatibility achieved by the instantly claimed composition. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abigail M. Cotton whose telephone number is (571) 272-8779. The examiner can normally be reached on 9:30-6:00, M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AMC